

REMARKS

Claims 1 through 4 and 6 through 46 are pending in this application.

Claims 1, 21, 35, 38 and 41 have been amended.

The Examiner's attention is respectfully invited to consider the status of the related patent application; Another national phase application under 35 U.S.C. §371 of PCT International Application No. PCT/IB99/00277 was issued on October 21, 2003 (U.S. Pat. No. 6,634,060).

I. Election/Restrictions

The Examiner asserted that newly submitted claims 35-37 and 44-46 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the process of forming the closure was not previously set forth in the claims, and moreover, a different process can be used to mold the closure wherein the closure parts can be molded separately and then secured together or the closure can be molded in an open position.

Applicant traverses this unilateral imposition of a requirement for restriction and current election by the Examiner, without authorization by Applicant.

The withdrawal of claims 35-37 and 44-46 is improper under 37 CFR §1.145, and unfairly deprives Applicant of an opportunity for reconsideration and review under 37. CFR §1.143 and 37 CFR §1.144.

The Examiner's attention is invited to consider that this application is a national stage application of the PCT application.

MPEP §1850 states that:

“Any international application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (PCT Article 3(4)(iii) and 17(3)(a), PCT Rule 3.1, and 37 CFR 1.475). Observance of this requirement is checked by the International Searching Authority and may be relevant in the national (or regional) phase.

The decision in *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 231 USPQ 590 (E.D. Va. 1986) held that the Patent and Trademark Office interpretation of 37 CFR 1.141(b)(2) as applied to unity of invention determinations in international applications was not in accordance with the Patent Cooperation Treaty and its implementing regulations. In the Caterpillar international application, the USPTO acting as an International Searching Authority, had held lack of unity of invention between a set of claims directed to a process for forming a sprocket and a set of claims drawn to an apparatus (die) for forging a sprocket. The court stated that it was an unreasonable interpretation to say that the expression "specifically designed" as found in former PCT Rule 13.2(ii) means that the process and apparatus have unity of invention if they can only be used with each other, as was set forth in MPEP § 806.05(e).

Therefore, when the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111. No change was made in restriction practice in United States national applications filed under 35 U.S.C. 111 outside the PCT.

In applying PCT Rule 13.2 to international applications as an International Searching Authority, an International Preliminary Examining Authority and to national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2.

PCT Rule 13.2, as it was modified effective July 1, 1992, **no longer specifies the combinations of categories of invention** which are considered to have unity of invention. Those categories, which now appear as a part of Annex B to the Administrative Instructions,

has been substituted with a statement describing the method for determining whether the requirement of unity of invention is satisfied. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. The determination is made based on the contents of the claims as interpreted in light of the description and drawings. Annex B also contains examples concerning unity of invention." (Emphasis added)

The Examiner cited 37 CFR 1.142(b) and MPEP §821.03 for the restriction requirement without considering the unity of invention. That is, the Examiner's test is not proper under the PCT rule.

As MPEP stated, PCT Rule 13.2, as it was modified effective July 1, 1992, no longer specifies the combinations of categories of invention which are considered to have unity of invention. Also, the consideration of unity of invention of claims of different categories should be made without regard to the practice in national applications filed under 35 U.S.C. 111.

Nonetheless, the Examiner did not consider whether the pending claims have unity of invention, and did conclude that the restriction is required because the product *as claimed* can be made by another different process. The Examiner's reasoning is clearly reversed by *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 231 USPQ 590 (E.D. Va. 1986). (The court stated that it was an unreasonable interpretation to say ... that the process and apparatus have unity of invention if they can only be used with each other, as was set forth in MPEP § 806.05(e).) (See also MPEP §1850.). Under the PCT rule, as long as there is unity of invention, the Examiner should consider all the claims.

As stated above, the proper test for “unity of invention” is whether there is a technical relationship among the claimed inventions involving one or more special technical features.

Annex B to the Administrative Instructions under the PCT contains examples concerning unity of invention.

The Examiner’s attention is respectfully invited to consider the Example 1 in ANNEX B to the Administrative Instructions under the PCT, Unity of Invention Part 2, Examples Concerning Unity of Invention.

wherein
“Claims 1: A method of manufacturing chemical substance X.
Claim 2: Substance X.
Claim 3. The use of substance X as an insecticide.
Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is substance X.”

Here, as recited in the last line of claims 35 and 44, the product made by the process claims 35-37 and 44-46 are directed to the closed injection molded closure. Therefore, both the products of claims 1-4, 6-34, and 38-43 and the products made by the process claims 35-37 and 44-46 have the common special technical feature of a closed injection molded closure.

Since there is unity of invention, the Examiner’s assertion is not proper.

II. Drawings

The Examiner stated that Fig. 1 should be designated by a legend such as - Prior art-.

Applicant filed Petition under 37 CFR §1.181 to withdraw the requirement to label Fig. 1 as “Prior Art”.

Inter alia, the Examiner's attention is invited to consider that Fig. 1 is prepared in an effort to illustrate Applicant's discovery of problems plagued in the art. By identifying deficiencies or problems in the prior art and addressing those deficiencies or those problems, Applicant completes the invention. As such, Applicant's effort to identify deficiencies or other undesirable features in the art, does not constitute "Prior Art" as that term is used under 35 U.S.C. §103, and defined by 35 U.S.C. §§102(a)-(g).

Withdrawal of the requirement to label Fig. 1 as "Prior Art" is respectfully requested.

III. Claim Objections

Claims 1 and 38 were objected to because of the cited informalities.

Claims 1 and 38 have been amended to delete the comma in claim 9 and to insert "a" before "first angle" in claim 38.

IV. Claim Rejections - 35 U.S.C. §112

Claims 21-34 and 38-40 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 21, the term "contained" has been corrected to the term "container", and the structure of the closure is more clearly defined by this Amendment. In claim 38, the antecedent basis error has been corrected.

V. Claim Rejections - 35 U.S.C. §102

Claims 1, 2, 6-10, 13, 14, 15, 17 and 38-43 stand rejected under 35 U.S.C. §102(b) as being anticipated by Nozawa (U.S. Pat. No. 5,148,912).

The examiner asserted that the closure of Nozawa illustrated in figures 1-6 anticipates the claimed closure, and further stated that, regarding the inclination of the planes of the hinge elements, the angle of the planes formed by the hinge elements of Nozawa is inclined relative to a closure axis.

The Examiner further stated that, wherein the claims do not set forth the direction of the closure axis and/or inclination of the planes, Nozawa anticipates this limitation since an angle of inclination can be greater than zero degrees and less than 360 degrees relative to an axis.

Applicant respectfully traverses this rejection for the following reasons.

First, the “planes” formed by Nozawa are not inclined relative to a “closure axis”.

In view of the Examiner’s reasoning recited in the Office action, it is not clear why the Examiner thinks that the planes of Nozawa are inclined to the closure axis.

If the Examiner conceived that a “closure axis” can be a line (*i.e.*, a imaginary slant line in Figs. 6, 8 and 9 of Nozawa) which is different from the line (*i.e.*, closure axis A) as shown in Fig. 2 (as amended on September 25, 2004) of the present application, please consider the meaning of the term “closure axis.”

“The terms of a claim will be given their ordinary meaning, unless it appears that the inventor used them differently.” *ZMI Corp. V. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 6 USPQ2d 1557 (Fed. Cir. 1988). In defining the meaning of key terms in a claim, reference may be had to the specification, the prosecution history, prior art, and other claims. *Minnesota Mining &*

Manufacturing Co. V. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992).

Here, the “closure axis” is clearly defined in the specification and Fig. 2 (See “A”, in Fig. 2, which is referred to as a closure axis.)

If the Examiner successfully traverses the above reasoning (i.e., the term “closure axis” should be interpreted as being a line which is different from the closure axis A of Fig. 2 of the present application), the Examiner’s attention is invited to consider that the ordinary or dictionary meaning of the term “axis” is (1) a straight line about which a body or geometric object rotates or may be conceived to rotate, or (2) a line about which the object is symmetric, or (3) a center line to which parts of a structure or body may be referred, or (4) an imaginary line to which elements of a work of art are referred for measurement or symmetry and the like. (*The American Heritage Dictionary of the English Languages*, 3rd ed., Houghton Mifflin Company.) Please also note that, to avoid any confusion, the term “a closure axis” in claims 1, 38 and 41 has been amended to “a central closure axis”.

With respect to the term “inclined”, it should be noted that the ordinary and/or dictionary meaning of “incline” is “to deviate from the horizontal or vertical.” Unlike the Examiner’s definition of “the incline angle”, an inclination angle under the ordinary and/or dictionary meaning does not include 90 degree, 180 degree, and 270 degree.

Even under the ordinary or dictionary meaning of the definition of “closure axis”, the planes of Nozawa are not inclined relative to any conceivable closure axis in Figs. 6-9 for the following reasons.

As shown in Fig. 8 of Nozawa, Nozawa clearly shows that the planes are vertical. Also, Fig. 9 of Nozawa more clearly shows that the plane (defined by 7a, 7c(11), 7b, and 7d(10)) in a closed position is vertical. Since the planes of Nozawa in a closed position are vertical in a closed position as shown in Figs. 8 and 9, the only imaginary lines which can be inclined relative to the planes in Figs. 6, 8 and 9 of Nozawa are imaginary slant lines. However, in view of the definition of the term “closure axis” in the specification as well as the ordinary or dictionary meaning, any imaginary slant line in Figs. 6, 8 and 9 of Nozawa cannot be regarded as a “closure axis”.

It should be noted that an inclination of *a plane relative to a line* (i.e., closure axis) is different from an inclination of *each line (on the plane) relative to the line* and an inclination of *a plane relative to another plane*. That is, here, the fact that some lines (i.e., 7c(11), 7d(10)) in the closed position may be inclined relative to the line of the closure axis does not mean that the **plane defined by the hinge connections** (i.e., 7c(11) and 7d(10)) is not inclined relative to a closure axis. Likewise, the fact that the plane defined by the hinge connections (i.e., 7c(11), 7d(10)) in the closed position may be inclined relative to another imaginary plane does not mean that the **plane defined by the hinge connections** (i.e., 7c(11) and 7d(10)) is not inclined relative to a closure axis.

For the foregoing reasons, the examiner’s anticipation rejection is not proper.

Second, Nozawa does not teach the feature of “the two connecting elements and the two pairs of hinge connections are accessible in the mould from the inside of the closure and from the outside of the closure.”

The Examiner stated that claims 1, 2, 6-10, 13, 14, 15, 17 and 38-43 is a product-by process claim, and that process limitation in a product-by-process claim is not considered for determination

of patentability.

The Examiner's assertion is not proper for the following reasons.

The fact that process terms are used in a product claim does not necessarily mean that the claim is product-by-process claim. For example, such terms as "etched," "welded," "interbonded by interfusion," and "condensation product" can be used to describe the physical characteristics of a product without changing the character of the claim into a product-by-process claim. Although those words appear to be process limitations, they are considered limitations on the structure of the invention, not words descriptive of a process. *In re Garnero*, 412 F.2d 276, 162 USPQ. 221 (CCPA 1969).

Here, the description of the product in the mold should be regarded as a structural limitation. The shape of a mold is necessarily translated into the shape of a product. Even if the recited feature in claims 1, 38 and 41 includes the process term, the recited feature describes the physical characteristics of the product by describing the arrangement of the product.

As admitted by the Examiner and MPEP §2113, even if product-by-process claims may not be limited to the manipulation of the recited steps, product-by-process claims are limited by the structure implied by the steps. It should be noted that this case is distinguished from the case wherein the product *of the prior art* is made merely by a different process which does not imply the novel structure.

Here, the feature of "the two connecting elements and the two pairs of hinge connections are accessible in the mould from the inside of the closure and from the outside of the closure implies the structure of the product for the above reasons. Therefore, even if claims 1, 35 and 41 are regarded

as product-by-process claims, the structure implied by the steps (*i.e.*, the feature of “the two connecting elements and the two pairs of hinge connections are accessible in the mould from the inside of the closure and from the outside of the closure”) should be considered for patentability determination.

Therefore, claims 1, 2, 6-10, 13, 14, 15, 17 and 38-43 are not anticipated by the prior art.

VI. Claim Rejections – 35 U.S.C. §103

1. Claims 3, 4 and 16 stand rejected under 35 U.S.C. §103 as being unpatentable over Nozawa ‘912 in view of Dubach (US 5,392,938).

The examiner asserted that Nozawa ‘912 taught the claimed closure except for at least one element initially connecting the two closure parts in the closed position, and that Dubach ‘938 taught that it was known to initially secure two hinged closure parts together.

Claims 3, 4 and 16 depend effectively from claim 1. As stated above, since claim 1 is patentable, claims 3, 4 and 16 are also patentable.

Therefore, the Examiner’s rejection should be withdrawn.

2. Claims 18 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nozawa in view of Altherr (U.S. Pat. No. 5,270,011) and Gach *et al.* (U.S. Patent No. 4,826,026), respectively.

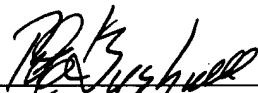
Claims 18 and 20 depend effectively from claim 1. As stated above, since claim 1 is patentable, claims 18 and 20 are also patentable.

Therefore, the Examiner's rejection should be withdrawn.

In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

This Response is accompanied with Petition for an extension of time and a fee of \$980.00. Should the Petition become lost or separated, the Commissioner is authorized to treat this paragraph as the requisite written petition. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,



Robert E. Bushnell,
Attorney for the Applicant
Registration No. 27,774

1522 "K" Street, N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

Folio: P56559PCT
Date: 10/13/04
I.D.: REB/JHP